

### **REMARKS**

This communication responds to the *Office Action* dated June 25, 2010. Claims 1, 12, 20, and 27 are amended. Support for the claim amendments may be found on at least page 9, lines 4-12 of Applicants' as-filed application. No claims are presently canceled. Claims 32 and 35 were previously canceled. Claims 36-39 are added. As a result, claims 1-31, 33, 34, and 36-39 are now pending in this application.

#### **New Claims**

Claims 36-39 are new. Support for the new claims may be found in the specification on at least page 7, lines 23-30 and page 18, lines 14-20. Applicants believe that no new matter has been introduced in the added claims. Additionally, Applicants respectfully submit that the new claims are patentably distinct over the references currently cited as a basis of rejection. Accordingly, Applicants respectfully request that the Examiner consider and allow the newly added claims.

#### **The Rejection of Claims Under § 103**

Claims 1-17, 19-31, 33, and 34 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over *Cheok* (U.S. Patent No. 6,934,906) in view of *Jeannin* (U.S. Published Patent Application No. 2002/0083469).

The recent U.S. Supreme Court decision of *KSR v. Teleflex* provides a tripartite test to evaluate obviousness.

The rationale to support a conclusion that a claim would have been obvious is that ***all the claimed elements were known in the prior art*** and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art. (*See KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 U.S.P.Q.2d 1385 (2007); *see also* MPEP § 2143. Emphasis added.)

Applicants will show that the cited references, either singly or in combination, neither teach nor suggest all limitations of Applicants' claims. Although other rationales for rejection under 35

U.S.C. §103(a) may exist, the basis for an obviousness rejection is still grounded in a consideration of all claim elements. “All words in a claim must be considered in judging the patentability of that claim against the prior art.”<sup>1</sup> Additionally, to render the claimed subject matter obvious, the prior art references must teach or suggest every feature of the claims.<sup>2</sup>

Independent claim 1 recites, in part,

[R]eceiving a presentation description in said system, said **presentation description** comprising a set of instructions that **define a plurality of manners** in which a portion of said first image and a portion of said second image may be combined

**selecting a manner** from the plurality of manners in which the portion of said first image and the portion of the second image are to be combined **based upon user preference information stored** in said system.<sup>3</sup>

Independent claims 12, 20, and 27 each recite at least similar claim language as that emphasized above with respect to claim 1.

In rejecting claim 1, the Examiner alleged that the presentation description is taught by the “scene description information 225 and integration instructions 222” citing to col. 4, line 56 – col. 5, line 38 of *Cheok*. *Cheok*, however, indicates that the “integration instructions 222 may be invoked when the MPEG-4 decoder instructions 221 encounter a reference to an external application in the scene description information 225.”<sup>4</sup> Thus, the scene description information of *Cheok* merely describes the scene and contains references to an external application, while the integration instructions of *Cheok* use “scene description information 225 to configure and start external application instructions [which] then render[s] the subscene in application window.”<sup>5</sup> Neither the scene description information nor the integration instructions of *Cheok* comprise “a set of instructions that define a plurality of manners in which a portion of said first image and a portion of said second image may be combined” as recited in claim 1.

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<sup>1</sup> *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). See also MPEP § 2143.03.

<sup>2</sup> See Manual of Patent Examining Procedure §§ 706.02(j), 2143(A) (2008); MPEP § 2142 (2006) (citing *In re Vaack*, 947 F.2d, 488 (Fed. Cir. 1991). Cited approvingly in *Ex parte WEN WEN* and *PATRICIA NG* at 7; Appeal No. 2009-000776; decided September 25, 2009.

<sup>3</sup> Emphasis added.

<sup>4</sup> *Cheok* at col. 5, lines 28-31.

<sup>5</sup> *Id.* at col. 5, lines 33-37.

The Examiner further alleged that “the manner of combination [in *Cheok*] is context dependent . . . , thus a plurality of manners are defined based on context.”<sup>6</sup> However, the cited portion of *Cheok* states that a “scene 150 is context dependent [whereby] different information is shown depending upon whether the user selects the Search, View or Reserve option.”<sup>7</sup> Just because a scene is context dependent based on a user’s interaction, does not in any manner teach or even suggest a “presentation description comprising **a set of instructions that define a plurality of manners**” as recited in claim 1.

It is further pointed out that claim 1 recites selection of “a manner from the plurality of manners . . . based upon user **preference information stored** in said system.” A user interaction at time of viewing a scene is not user preference information stored in the system. Thus, *Cheok* is completely silent with respect to “selecting a manner from the plurality of manners . . . based upon user preference information stored in said system” as recited in claim 1.

The Examiner admitted that *Cheok* “does not further explicitly teach that the selected manner is chosen based on user preference information in the system” but alleged that *Jeannin* provides “objects in accordance with a user preference of the system by which a user selects which type of advertisements should be display.”<sup>8</sup> The user profile of *Jeannin* allows the user to “specify the types of objects that he wishes to view or be informed about.”<sup>9</sup> However, this user profile is used to notify the user of the availability of the advertisement matching the specified types of objects in the audiovisual program. For example,

The viewer may, for example, wish to review advertisements about cars but not about electronic gadgets. In this case, the viewer would highlight the cars category 235 in FIG. 6, as an example. **Using the user profile** 230, where an audiovisual program displays cars and electronic gadgets and has advertisements for both of these types of objects, and where the viewer is to be notified of the availability of the advertisement, the **viewer need only be notified** about the car advertisements but not the advertisements associated with the electronic gadgets.<sup>10</sup>

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<sup>6</sup> *Office Action* at 4 (citing to *Cheok* at col. 3, lines 44-46).

<sup>7</sup> *Cheok* at col. 3, lines 44-47.

<sup>8</sup> *Office Action* at 5.

<sup>9</sup> *Jeannin* at [0039].

<sup>10</sup> *Ibid.* (emphasis added).

The notification to a user of an available advertisement does not in any manner teach or even suggest a selection of “a manner from the plurality of manners in which the portion of said first image and the portion of the second image **are to be combined**” as recited in claim 1.

Since Applicants have shown that not all the claimed elements were known as required by *KSR*, by *Cheok* or *Jeannin*, singly or in combination, Applicants respectfully request the Examiner reconsider and withdraw the rejection under 35 U.S.C. §103 with regard to independent claims 1, 12, 20, and 27. Further, since claims 1-11, 13-17, 19, 21-26, 28-31, 33, and 34 depend from claims 1, 12, 20, or 27, they too are allowable for at least the same reasons as their respective base claim. Furthermore, these dependent claims each may contain additional patentable subject matter.

Claim 18 was rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over *Cheok* in view of *Jeannin* and *Duncombe* (U.S. Patent No. 6,792,573). Applicants traverse the rejection of claim 18. Claim 18 depends from claim 12, which Applicants have asserted are patentable over the cited art. The cited reference to *Duncombe* does not cure the deficiency of *Cheok* and *Jeannin*. Therefore, claim 18 is allowable for at least the same reasons as those provided for claim 12. Furthermore, claim 18 may contain additional patentable subject matter. As such, Applicants request the reconsideration and withdraw of the rejection of claim 18.

**CONCLUSION**

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the undersigned at (408) 278-4057 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.  
P.O. Box 2938  
Minneapolis, MN 55402--0938  
(408) 278-4057

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By / Susan Yee /  
Susan Yee  
Reg. No. 41,388

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this day of August, 2010 27 September 2010

John D. Gustav-Wrathall  
Name

/ John D. Gustav-Wrathall /  
Signature